



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,790	09/21/2000	Jan Slomianny	200-19	1128

7590 05/08/2002

J Rodman Steele Jr
Quarles & Brady
Suite 400
222 Lakeview Avenue
West Palm Beach, FL 33401

EXAMINER

NGUYEN, JUDY

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/646,790	SLOMIANNY ET AL.
	Examiner	Art Unit
	Judy Nguyen	2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species I – Figure 1

Species II - Figure 2

Species III – no drawing or support in the specification; it appears as directed to a mechanical hindered system for preventing insertion of unauthorized bottle.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 1-6, species I
Claim 8, species II
Claim 7, species III

The following claim is generic: since species III has not been illustrated nor described in the disclosure, the generic claim cannot be determined. Although claim 1 is the only independent claim, the feature of species III in claim 7 does not appear to be combinable with the features recited in claim 1.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: species I and II lack the feature that mechanically hindered the insertion of an unauthorized bottle of species III and vice versa. Species I and II lack the same label for storing coded information.

During a telephone conversation with Mr. Mark Passler on 4/19/02 a provisional election was made without traverse to prosecute the invention of species I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 and 8 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the printer having at least four bottles (at least one recited on line 3, at least two recited on line 9, and a new one recited on line 14 of claim 1) must be shown or the feature canceled from the claim. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required: the volume of the reservoir bottle is more than six or ten times as recited in claims 3 and 4 and the computer being provided with a memory as recited in claim 6.

Claim Objections

4. Claims 1, 2, 6 are objected to because of the following informalities:

- The lower quotation marks (on lines 19 and 21 of claim 1 and line 2 of claim 2) before the word "reservoir" should be an upper quotation marks.
- "these data" (claim 6) lacks proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for feeding the coded information on a label, does not

reasonably provide enablement for feeding the label into the computer as recited on lines 13-14. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with this claim. It appears that the coded information on the label is being read by or fed into the computer, as opposed to the label itself being fed into computer.

7. Claims 1 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With respect to claim 1, the specification describes a printer having only one exchangeable reservoir bottle
24. Since the claims are so indefinite as set forth below, one skilled in the art would not know how to make and/or use the invention having at least four reservoir bottles as recited in the claim. With respect to claim 6, the specification does not describe the computer being provided with any memory in which the information from the label is stored and that the information is deleted when a new reservoir bottle is inserted. It is noted that the information is already stored on the label of the bottle. One skilled in the art would not know any apparent reason why another device is needed for storing the same information.

Art Unit: 2861

8. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. A keyboard or scanning device is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In view of the specification, the label (presuming that applicant meant the coded information on the label) cannot be fed into the computer without either the keyboard 40 or the scanning device 42 for keying or scanning, respectively, the label. Hence, the keyboard or the scanning device is essential to perform the claimed function.
9. Claims 2-5 are also rejected under 35 U.S.C. 112, first paragraph, accordingly, because they depended on the rejected claim 1 as set forth above.
10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1:

- The phrases "for example" (line 4) and "e.g." (lines 11, 17) render the claim indefinite because it is unclear whether the limitations preceding the phrases are part of the claimed invention. See MPEP § 2173.05(d).
- The phrase "the reservoir bottles" (line 10) lacks proper antecedent basis. It is unclear whether it refers to the at least two reservoir bottles or the combination of the least two reservoir bottles (line 9) and the at least one exchangeable reservoir bottle (line 3).
- The word "they" (line 11) also lacks proper antecedent basis because it is unclear what "they" supposed to be.
- The phrase "and so on" (line 12) renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "and so on"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).
- It is unclear whether "a computer" recited on line 2 and the one recited on line 13 are one in the same.
- The recitation of "the label is fed into the computer when inserting a new reservoir bottle" (lines 13-14) is indefinite for the following reasons. There is no inter-relationship between the label and a new reservoir bottle. Hence, it is unclear how the label can be fed into the computer when inserting a new reservoir bottle. Furthermore, inserting the new reservoir bottle to where? The printer previously recited as being provided with at

least three reservoir bottles. It is unclear how this new reservoir bottle inter-related with the other three.

- The phrase "the reservoir bottle" (line 19) lacks proper antecedent basis. Which one? There were at least four bottles previously recited.

Regarding claim 2:

- "it" and "the tapping of fluid" lack proper antecedent basis. What is "it"? And how does "it" suspend the tapping of fluid?

Regarding claim 3:

- The phrase "in particular" renders the claim indefinite because it is unclear whether the limitation following the phrase is part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 6:

- The words "like" and "preferably" render the claim indefinite because it is unclear whether the limitations following these words are part of the claimed invention. See MPEP § 2173.05(d).

Other depended are also rejected under 35 U.S.C. 112, second paragraph, accordingly, because they depended on the rejected claim 1 as set forth above.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Cowger et al (US 5,788,388).

Cowger et al (see particularly Figure 3) discloses:

- A computer (37)
- At least one exchangeable reservoir bottle (12)
- An installed intermediate container (76)
- An installed arrangement (92)

- A label (20) carrying coded information
- Other limitations are considered inherent by the disclosure.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowger et al in view of Hawkins (EP 0 720 916 A2).

Cowger et al discloses all elements of the claimed invention except for the computer being provided with a memory.

However, Hawkins discloses a computer being provided with a memory (20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the memory as taught by Hawkins in the computer of Cowger et al for the purpose of allowing multiple partially used

Art Unit: 2861

bottles to be inserted and removed from the printer, but preventing two printers to share the same bottle.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy Nguyen whose telephone number is (703) 305-7062. The examiner can normally be reached on Monday - Friday. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JUDY NGUYEN
PRIMARY EXAMINER

May 2, 2002